UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,020	08/02/2001	Alicia Anne Chastain	RSW920010065US1	7793

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EXAMINER
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ART UNIT	PAPER NUMBER
2173	3

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/921,020	CHASTAIN ET AL.
	Examiner	**Art Unit**
	Tadesse Hailu	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>02 August 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some *   c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the patent application number 09/921,020

filed on August 2, 2001.

Information Disclosure Statement

2.   The submitted Information Disclosure Statement with references is considered

and entered into the file.

Status of the claims

3.   The pending claims 1-21 are examined herein as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham

et al (US Pat No 6,457,026).

With regard to claims 1, 18 and 21:

Graham et al ("Graham") discloses a computer-implemented method for

researching highlighted or annotated text in an electronically stored document (or

electronic book), which contains plurality of pages including table of contents (see Figs.

2A-2D, 3, 4, 9A and 9B).

The method includes among other things, receiving a user input via an input

device (Fig. 1, #36) selecting the text from the electronic document to form selected text

(see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4,

lines 3-28).

The method also includes *automatic* web *search* process (automatically initiating

a search), wherein when this web *search* process is enabled (via user input), whenever

a particular keyword or key phrase is found frequently near where a defined concept is

determined to be discussed, a web *search* tool such as Alta Vista^{TM} is employed to look

on the World Wide Web for documents containing the keyword (the selected text) or key

phrase (column 7, lines 46-57).

With regard to claim 2:

Graham further discloses a search for at least one item relevant to the selected

text includes at least a World Wide Web document or another electronic document

(column 7, lines 46-57).

With regard to claim 3:

Graham further discloses maintaining (storing) the selected text in a user profile

file 516 data structure (Figs. 5, and 6A-6C, column 5, lines 13-16).

With regard to claims 4 and 12:

Graham discloses a method and system to facilitate reading a document.

Graham further discloses a document display system that is easily personalizable and

flexible as well (column 1, lines 47-50). Graham further discloses a pattern identification

stage that looks for particular patterns (or structure) in the parsed text output of text

processing stage. The particular patterns searched for are determined by the contents

of user profile file 516 (Fig. 6B, column 5, lines 32-50).

With regard to claim 5:

Graham also discloses that the selected text or key phrase is a highlighted text,

wherein the user may select any highlighted key phrase with the mouse (Fig. 2B, #220,

column 3, lines 57-63).

With regard to claim 6:

As illustrated in Fig. 2, Graham further discloses that the highlighted text is text in

a different color from unselected text, bolded text, and text with a different font type from

unselected text (column 3, lines 57-63, Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

With regard to claim 7:

Graham further discloses that the highlighted text is the entire sentence (Fig. 2C,

#224) (or a notated passage of text) including phrases relevant to concepts of interest,

which are highlighted in the electronic documents (or electronic book) (column 4, lines

3-9).

With regard to claim 8:

Furthermore, as described above, Graham further discloses that the highlighted text is a highlighted passage of text in the electronic document (or electronic book) (column 4, lines 3-9, Fig. 2C, #224).

With regard to claim 9:

Graham further discloses document browser 506, receiving and viewing (or presenting) the search result to a user (Fig. 5, column 4, lines 45-column 5, lines 17).

With regard to claim 10:

Graham further discloses receiving a result is initiated using a search engine, such as, for example, a web *search* tool such as *Alta* Vista ™ is employed to look on the World Wide Web for documents containing the keyword or key phrase (column 7, lines 46-57).

With regard to claims 11 and 19:

Graham discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method includes among other things, responsive to a selecting the highlighted text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28) within the document, preparing and transmitting (via document

browser 506) the selected highlighted text to be searched by a web search tool such as

Alta Vista ™ (column 7, lines 46-57).

The method further includes receiving (via document browser 506) the search

result from the web search (column 7, lines 46-57).

<u>With regard to claim 13:</u>

Graham further discloses that the search profile includes search criteria, such as,

or example searching by concept, title, name or keyword (see Fig. 8, column 6, lines

62-column) 7, lines 12).

<u>With regard to claim 14:</u>

As illustrated in Figs. 2A-2D, 3, 4, 9A and 9B, Graham further discloses that the

electronic document which is an electronic book consisting of plurality of pages

including topics page (Fig. 3) and a table of contents page (Fig. 4).

<u>With regard to claim 15:</u>

As illustrated in Figs. 2A-2D, 3, 4, 9A and 9B, Graham further discloses that the

electronic document which is an electronic book is shown in a web page.

<u>With regard to claim 16:</u>

Graham also discloses that designation or marking of the text is made by

highlighting the text in the electronic document (Fig. 2B, #220, column 3, lines 57-63).

<u>With regard to claim 17:</u>

Graham discloses a computer-implemented system for researching highlighted

or annotated text in an electronically stored document (or electronic book), which

contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B, column 4, lines 10-17).

The method includes among other things, a document browser 506 for receiving results of researched selected text (column 7, lines 46-57).

Similarly, the method also enables the document browser 506 to retrieve (download) the results of researched selected text (column 7, lines 46-57).

Furthermore, the method also enables the document browser 506 to display the results of researched selected text (Figs. 5, and 6A through 6C, column 5, lines 1-16; column 5, lines 17-65).

With regard to claim 20:

Graham discloses a data processing system (**Fig. 1, #10**) comprising: a bus system (**12**); a communication unit (**40**) connected to the bus system; a memory (**16**) connected to the bus system, wherein the memory includes a set of instructions.

Graham further discloses a processing unit (**14**) connected to the bus system, wherein the processing unit executes the set of instruction to receiving a user input (**30** and **36**) selecting the text from the electronic book to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

Graham also discloses automatic web search process (automatically initiating a search) (column 7, lines 46-57), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista™

is employed to look on the World Wide Web for documents containing the keyword (the

selected text) or key phrase (column 7, lines 46-57).

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-

2799. The Examiner can normally be reached on M-F from 10:00 - 6:30 ET. If attempts

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John

Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

6.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

Tadesse Hailu

June 10, 2004